

REMARKS

The Applicant thanks the Examiner for the careful review and consideration of the current application. Applicant appreciates the comments regarding the applicability of the Applicants' previously presented arguments to the current case, and the scrutiny applied to them. All of the new claims contain a sufficient basis in the specification, and do not have new material.

I. Status

In the Office Action, Claims 1 and 3 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,583,922 (Davis) in view of legal precedence-rearrangement of parts (MPEP 2144.04 VI C). Claim 2 stands rejected under 35 U.S.C. §103(a) over Davis in view of legal precedence-rearrangement of parts, further in view of precedence-changes in shape (MPEP 2144.04 IV B) as being allegedly unpatentable. Claim 5 stands rejected under 35 U.S.C. §103(a) over Davis in view of legal precedence-rearrangement of parts, further in view of U.S. Patent No. 5,862,214 (Aggus). Claim 6 stands rejected under 35 U.S.C. §103(a) over Davis in view of legal precedence-rearrangement of parts, further in view of U.S. Patent No. 6,198,632 (Goff).

Claim 4 stands rejected under 35 U.S.C. §103(a) over Davis in view of legal precedence-rearrangement of parts, further in view of allegedly well known prior art (MPEP 2144.03).

New Claims 12-16 have been added. It is believed that, in light of the previous actions and the cited art, that these new Claims are allowable. Applicant accordingly urges Examiner to make a statement to that effect.

II. Background

Based on the plethora of rejections that this application has faced, Applicant would like to provide a background to the Examiner. Applicant hopes that the background will lead the Examiner to a better understanding of the invention, and why the arguments to the rejections are not rote.

In many situations, like in a hotel room, a traveler might wish to enjoy a fast network connection to the outside world. Many older buildings don't have a separate network wire strung, nor do they have separate network ports. To rewire and supply a wall mounted port to each and every room in an older building would be costly and time consuming. The claimed invention is directed to allowing for network functionality without such expensive retrofits. In this case, the invention allows for a very efficient means of providing network access without the added refit costs. Further, the invention allows dual usage of the telephony device and any network interconnects.

In this context, nothing that the Examiner has cited, nor any doctrinal concepts that the Examiner has used in the rejections, makes the Applicant believe that the full functionality of the invention is truly understood by the Examiner. Hopefully, this background will give some sense to which the claims are directed.

II. Discussion of Rejections under §103

A. Standard under 35 U.S.C. §103

According to the Manual of Patent Examining Procedure (M.P.E.P.),

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all the claim limitations*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.” (emphasis added)¹

B. Rejections over Davis in view of legal-precedence-rearrangement.

Claims 1 and 3 stand rejected under 35 U.S.C. §103 over Davis in view of legal-precedence-rearrangement. A closer reading of the cited art reveals that this prior art combination does not reveal the portions of the claimed invention. Accordingly the rejections of Claims 1 and 3 as recited in this Action do not establish a *prima facie* case of obviousness.

¹ M.P.E.P. §2143

1. **Claim 1**

a. “networking card” and “digital data”

Claim 1 is directed to an apparatus that Claim 1 is directed to an apparatus that has, among other portions, “a *networking card* . . . operably connected to . . . interconnection logic,” where “*digital data from the network card*” is “sent across a telephone wire.”

In the Office Action (“OA”), it is asserted that a “modem [disclosed in Davis] reads on the claimed ‘networking’ card” (OA, p.3, last full paragraph). It is also stated in the Office Action that “digital data from the modem . . . [is] sent across the telephone line[.]” *Id.*

Applicant strenuously disagrees with this assessment. Davis explicitly teaches that the modem in question is not a “network card”, and cannot send “digital signals” across the phone line. Specifically, Davis states that the “data transmit block 254 [contained in the modem] . . . modulates and transmits a[n] [] analog signal [over the telephone wire.]” (Davis, col. 18, lines 23-24.) This stands as a testament that the modem of Davis is true to its name – i.e. a MODulator/DEModulator.

Correspondingly, the portions of Claim 26 reciting “a *networking card* . . . operably connected to . . . interconnection logic,” where “*digital data from the network card*” is “sent across a telephone wire” is specifically not shown in the Davis reference.

b. Legal precedence – rearrangement of parts.

The Examiner baldly states that the arrangement of a shell adapted to fit underneath a phone and to hold various telecommunications circuitries would be “obvious” to one skilled in the art for the purpose of making better use of space. While the Examiner has noted a good outcome, the argument fails as a matter of law. “The *prior art* [not the Examiner’s bald assertions] must provide a motivation or reason . . . without benefit of the [present] specification to make changes in the *reference* device.” M.P.E.P. 2144.04 VI C, quoting *Ex Parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). (Emphasis Added.)

First, only the Examiner provided the reason. Absolutely NO prior art backs that assertion up as *required* by law. Second, the Davis reference only seems to imply a shell. There is NO impetus or suggestion about making the shell in such a manner to perform ANY function, let alone those promulgated by the Examiner. Accordingly, the Examiner’s reliance on this doctrine is misplaced. Thus, the Examiner cannot rely on the portions supplied based on this principle, since there is not a mention of any prior art that provides a motivation or reason to make the changes.

c. Conclusion for Claim 1

The inclusion of the legal precedence-rearrangement does not fix the shortcoming of Davis. Further, there seems to be no valid reason for even including the changes to the reference contemplated by the doctrine cited. For these reasons, among others, the

rejection of Claim 1 under §103 over Davis in light of legal precedence-rearrangement is respectfully traversed. Correspondingly, Applicant respectfully requests that Claim 1 be passed to allowance.

2. Claim 3

Claim 3 depends from Claim 1. Accordingly, for the reason noted above relating to Claim 1, among others, the rejection of Claim 3 under §103 over Davis in light of legal precedence-rearrangement is respectfully traversed.

C. Rejections over Davis in view of legal-precedence-rearrangement, further in view of precedence-changes in shape.

Claim 2 stands rejected under 35 U.S.C. §103(a) over Davis in view of legal precedence-rearrangement of parts, further in view of of precedence-changes in shape. Claim 2 depends from Claim 1. The addition of the precedence-changes in shape does not obviate the shortcomings in the prima facie case, detailed above in relation to Claim 1. For this reason, among others, Applicant respectfully traverses the rejection of Claim 2.

D. Rejections over Davis in view of legal-precedence-rearrangement, further in view of Aggus

Claim 5 stands rejected under 35 U.S.C. §103(a) over Davis in view of legal precedence-rearrangement of parts, further in view of Aggus. Claim 5 depends from Claim 1. The addition of the Aggus does not obviate the shortcomings in the prima facie case, detailed above in relation to Claim 1. For this reason, among others, Applicant respectfully traverses the rejection of Claim 5.

E. Rejections over Davis in view of legal-precedence-rearrangement, further in view of Goff.

Claim 6 stands rejected under 35 U.S.C. §103(a) over Davis in view of legal precedence-rearrangement of parts, further in view of U.S. Patent No. 6,198,632 (Goff). Claim 6 depends from Claim 1. The addition of the Goff does not obviate the shortcomings in the prima facie case, detailed above in relation to Claim 1. For this reason, among others, Applicant respectfully traverses the rejection of Claim 6.

F. Rejections over Davis in view of legal-precedence-rearrangement, further in view of allegedly well known prior art.

Claim 4 stands rejected under 35 U.S.C. §103(a) over Davis in view of legal precedence-rearrangement of parts, further in view of allegedly well known prior art (MPEP 2144.03). Claim 4 depends from Claim 1. The addition of the alleged well known prior art does not obviate the shortcomings in the prima facie case, detailed above

in relation to Claim 1. For this reason, among others, Applicant respectfully traverses the rejection of Claim 4.

III. New Claims

New Claims 12-16 have been added. These claims have many of the same features as described in relation to Claim 1. For these reasons, among others, it is believed that these new Claims 12-16 are allowable as well.

IV. Note

Applicant respectfully requests a closure to what appears to be a continuous barrage of art and rejections. With all due respect, the Examiner should note that the numbers of pieces of art to reject the claimed matter *in toto* through three papers has now grown to an overripe 7 pieces, and using “official doctrine” in attempting fill in portions at least another 7 different times. Applicant respectfully asserts that the number of times the that the Office has “attempted a crack” at the claimed and the amount of “doctrinal sandbags” that the Office has used is growing excessive.

Applicant is mindful of the ongoing responsibility of the Office, but wonders all the same if the current process is to be an everlasting “trial in the Office”, or whether the process will terminate at some point.

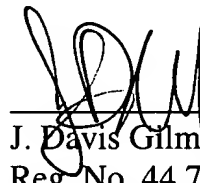
V. Conclusion

It is believed that this Response and related remark places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

It is believed that no extension is required for this response. The Commissioner is hereby authorized to deduct the proper amount from Deposit Account 50-1698 for the new claims.

Respectfully submitted,
THELEN REID & PRIEST LLP



J. Davis Gilmer
Reg. No. 44,711

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THELEN REID & PRIEST LLP
P.O. Box 640640
San Jose, CA 95164-0640
(408) 292-5800
(408) 287-8040